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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,272	07/29/2003	Peter Toop	GJE-7133	5688

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EXAMINER

WILLSE, DAVID H

ART UNIT PAPER NUMBER

3738

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/629,272	TOOP, PETER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dave Willse	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on July 29, 2003, is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2-13-04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

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The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter involving the posterior capsular sac itself (MPEP 2105, last paragraph). It is recommended that language such as “an annular rim configured to contact the posterior capsular sac” be used in order to avoid the “in use” positive recitation of the posterior capsular sac.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 2, “the plane” lacks a proper antecedent basis. In claim 3, “the anterior surface” lacks a proper antecedent basis. In claim 4, lines 2 and 3, “the proximal part” and “the distal part” (respectively) lack proper antecedent bases. In claim 6, lines 1-2, “the, or each, stage of compression” is indefinite and confusing; on line 3, “the proximal end” and “the distal end” lack proper antecedent bases.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nagamoto, JP 8-257046 A: English abstracts; Figures 1-4.

Claims 1, 2, 7, and 8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Lai et al., US 2004/0002757 A1. Regarding claim 2: paragraphs **0025** and **0026**. Regarding claims 7 and 8, Figures 5 and 6 illustrate the thickness of the rim **F** gradually tapering toward an apex (paragraphs **0027** and **0028**).

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grendahl, US 4,781,717, which discloses an optic **12**, one or more haptics (column 2, lines 53-55), and an annular rim **18**. The unillustrated loops or haptics being compressible in a plane of the lens would have been immediately obvious, if not inherent, because loops or haptics typically hold an intraocular lens in place by virtue of their resiliency and because all intraocular lens materials are compressible to some extent. Regarding claim 2, because of the bi-convex geometry of the optic (column 1, lines 60-61), the optic **12** is *capable* of touching the posterior capsular sac, whether or not such was the intent.

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Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knolle, US 4,588,405, in view of Nagamoto, JP 8-257046 A. Knolle discloses an optic **13** and loops or haptics **15** and **17** that can be compressed in the plane of the lens (Figure 4; column 5, lines 15-27). Knolle lacks an annular rim for contact with the posterior capsular sac. Since the Knolle invention is “particularly adapted for mounting within the capsular bag of the posterior chamber” (column 2, lines 1-2) and since the ordinary practitioner would have been well aware of the need to prevent posterior capsule opacification, to incorporate such an annular rim in a manner prescribed by Nagamoto, for example, would have been obvious from the well known success of mechanical means for inhibiting epithelial cell formation on the IOL, with further motivation having been provided by the goal of Knolle “to maximize the length of contact with the adjacent structure of the eye” so as to reduce loading on the eye (column 3, lines 9-12; column 2, lines 62-66), and such an effect would have been supplemented by the ring. Regarding claims 4-6, a proximal part of the haptic **15** is *capable* of being fully compressed, as seen in Figure 4, and the distal part is *capable* of being compressed in a second stage by, for example, forcing outer segment **19** to contact inner segment **25** (by forceps or the like) or by turning a distal end of the haptic inwardly towards a proximal end of the haptic.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse  
Primary Examiner  
Art Unit 3738